

# Google v. Oracle and the Future of Software Development

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The decade-old battle between two technology powerhouses—Google and Oracle—potentially reshaping the future of software will now continue into the Supreme Court’s next term.<sup>1</sup> Referred to in the media as the copyright lawsuit of the decade, *Google LLC v. Oracle America Inc.*, involves important issues related to the future of software development and restrictions on software interoperability.

At the center of the dispute is the copyrightability of software interfaces—particularly Java language’s application programming interfaces (APIs) that allow third-party programs to interact with the software. Software interfaces convey information and instructions between computer programs and platforms (the digital equivalent of an electrical outlet or a car’s steering wheel). Sun Microsystems originally developed the Java language and the APIs.<sup>2</sup>

In 2005, Google and Sun began discussing a partnership that would have allowed Google to adapt the Java platform for smartphones. Google’s plan was to incorporate Java’s Standard Edition (SE) programming libraries (including the APIs) into the Android operating system. In 2010, Oracle purchased Sun Microsystems and acquired ownership of Java’s SE libraries and the APIs. Meanwhile, negotiations among Google/Sun/Oracle went nowhere and no agreement was ever reached. In the absence of such agreement, Google used some of the Java APIs for customizing its Android platform. Oracle sued Google claiming that Google copied the structure, sequence and organization of the software code for 37 packages in its Java API, thereby infringing its Java copyrights. Google countered that the Java APIs are programmer declarations that simply tell how to access the prewritten methods/functions to perform certain tasks. In other words, the Java APIs are methods of operations/functions not entitled to copyright protection. After years of litigation,<sup>3</sup> the dispute reached the Federal Circuit in 2017.

On reversing the lower court’s judgments in Google’s favor the Federal Circuit first deemed Java API interfaces to be copyrightable and then held that Google’s reuse of such APIs could not be fair use as a matter of law. The ruling further amplified the conflicts among the various courts of appeals in the context of copyrightability of software interfaces and the merger doctrine. Google filed a cert petition in January 2019, and the Supreme Court granted the petition on November 15, 2019.

In its petition and briefs, Google primarily contends that, first, the Java APIs are not copyrightable under Section 102(b)<sup>4</sup> and, second, even if they are copyrightable, the elements replicated by Google fall under the fair-use doctrine.

<sup>1</sup> The case was on docket for decision this term. It has been moved for oral argument to the fall of 2020. Interestingly, some Intellectual Property law professors also pointed out that the Federal Circuit’s ruling, which had awarded victory to Oracle, violated the U.S. Constitution’s Seventh Amendment. The Supreme Court requested supplemental briefing on this issue.

<sup>2</sup> Sun Microsystems released the Java language in the 1990s and made it free and open for all to use without a license.

<sup>3</sup> The case was brought before the United States District Court for the Northern District of California twice and appealed to the United States Court of Appeals for the Federal Circuit twice. In the last round, in denying Oracle’s copyright claims, the district court held that the Java API declarations were not copyrightable because they constituted a “method of operation” under 17 U.S.C. § 102(b). The court further held that the declarations were not copyrightable under the merger doctrine, which provides that, “when there is only one (or only a few) ways to express something, then no one can claim ownership of such expression by copyright.” *Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974 (N.D. Cal. 2012).

<sup>4</sup> 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

Respondent Oracle, of course, argues otherwise. In addition, multiple technology companies filed amici briefs in support of both parties.

The Supreme Court's analysis will primarily rest on whether the merger doctrine applies to the Java APIs.<sup>5</sup> The merger doctrine—whereby an idea (not copyrightable) merges with its expression (otherwise copyrightable)—precludes copyright protection for certain expressions. If the Court agrees with Google that the Java APIs are the *only and essential means of accomplishing a given task*—in other words, the idea underlying the APIs is incapable of being expressed in more than one way—Java APIs are not protected and their use is not copyright infringement. However, there are a few nuances that the Court needs to take into consideration. As Oracle argued, implicit in Google's assertion is the crucial distinction between programmers who can use Oracle's Java APIs for creating new applications (with a license from Oracle) versus platform developers (like Google) who copy it to commercialize and unfairly compete with their own computing platforms. If the Court agrees with Oracle, next comes the issue of whether Google's use of the APIs constitutes fair use.

The fair-use doctrine, which has long been a cornerstone of copyright law, may be Google's savior if it loses on the first issue. The application of the doctrine also raises some interesting questions outside the realm of copyright law. As Google pointed out in its brief, the Federal Circuit misapplied the fair-use doctrine by overturning a jury verdict. Previously, the Federal Circuit remanded the same fair-use issue to the jury out of respect for the limit of its appellate function. After the retrial and a jury verdict in Google's favor on fair use, the Federal Circuit took the unusual step of setting aside the jury's verdict and deciding fair use in Oracle's favor as a matter of law. It could very well be that the Supreme Court disagrees with the Federal Circuit's reasoning and decision (e.g., as appellate courts second-guessing factual determinations made by a jury) and agrees with Google on the fair-use issue.

Either way, the Supreme Court's decision in *Google v. Oracle*—expected sometime during the October 2020–2021 term—will likely have a significant effect on software innovation. The Court's decision could potentially change how software applications are developed and whether or not those applications will be accessible in and compatible with different operating systems and platforms. Only time will tell which groups will most benefit and which groups will be most adversely affected by the outcome.

If you have questions about, please contact **Robert S. Rigg** at + 1 (312) 609-7766, **Sudip K. Mitra** at +1 (312) 609-7617 or any other Vedder Price attorney with whom you work.

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<sup>5</sup> Section 102(b) of the Copyright Act prevents an author from securing the exclusive right to an idea or function itself, as opposed to the author's expression thereof. 17 U.S.C. § 102(b).